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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,549	08/18/2003	Richard Frederick Dechant		1961

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RICHARD FREDERICK DECHANT
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EXAMINER

GRAFFEO, MICHELLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/642,549

Applicant(s)

DECHANT, RICHARD FREDERICK

Office Action Summary

Examiner

Michelle Graffeo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim 1 is pending and examined.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of visible tumors via direct application of the composition as well as precancerous cells using camphor and

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resorcinol or mixtures thereof and a chemotherapeutic agent sulfathiazole (as defined by the prior art but not the instant specification), does not reasonably provide enablement for the treatment of all carcinomas, melanomas, susceptible forms of cancer etc. Nor is the claim enabled for treating such cancers via contact between sublingual or rectal tissues and the composition. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988) as to undue experimentation.

The factors include:

- 1) the nature of the invention;
- 2) the breadth of the claims;
- 3) the predictability or unpredictability of the art based on the skill of one in the art;
- 4) the amount of direction or guidance presented;
- 5) the presence or absence of working examples; and
- 6) the quantity of experimentation necessary for one skilled in the art based on the state of the art;

Each factor is addressed below on the basis of comparison of the disclosure, the claims and the state of the art in the assessment of undue experimentation.

- 1) the nature of the invention; the claims are directed to a method of treating carcinomas, melanomas, colorectal cancer, ovarian cancer and other

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susceptible forms of cancer comprising the application of a composition comprising resorcinol, camphor, sulfathiazole and propylene glycol.

2) the breadth of the claims; the scope of the claims includes the treatment of the above forms of cancer via applying the composition to rectal and sublingual tissue.

3) the predictability or unpredictability of the art; the applicant has not provided any competent evidence or disclosed any tests that are highly predictive for the anticancer effects of the instant composition. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Therefore, since treatments for all cancers described above are not known, especially the treatment of all the claimed cancers via sublingual and rectal tissues are not shown or taught in the art per se, the amount of predictability in the art is lacking and therefore the enablement.

4) the amount of direction or guidance presented; the instant application provides no guidance for the treatment of cancer via contacting the claimed composition with sublingual and rectal tissues.

5) the presence or absence of working examples; there are no working examples provided in the instant application.

6) the quantity of experimentation necessary; the quantity of experimentation would be an undue burden to one of ordinary skill in the art and

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amount to the trial and error type of experimentation. Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention and the unpredictability of the route of administration, and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

In consideration of each of factors 1-6, it is apparent that there is undue experimentation because of variability in prediction of outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent Application No 2003/0175328 to Shefer et al.

Shefer et al. teach a method of topically treating (see Abstract) precancerous cells (see paragraph 24) comprising camphor and resorcinol or mixtures thereof (see

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paragraph 39) and a chemotherapeutic agent such as sulfathiazole (see paragraph 52) and a solubilizer such as propylene glycol (see paragraph 21) wherein the active agent is present in an amount of from 0.001% to about 80%.

Shefer et al. do not specifically teach the application of the composition via a cotton swab for 4-5 minutes.

Shefer et al. teach the application of the composition for a recommended treatment period (see paragraph 65) and also teach topical administration of the composition. Thus, one of skill in the art would have found it obvious to optimize the treatment duration and method of application. Additionally, Shefer et al. do not specifically recite a method of treating cancer, but yet teach a method of treating precancerous tissues. Nonetheless, the composition admittedly comprises a chemotherapeutic drug, sulfathiazole, which ultimately suggests its use as an anticancer composition. Thus, the claimed invention was within the ordinary skill in the art to make and use at the time it was made and was as a whole, *prima facie* obvious.

No claim is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Graffeo whose telephone number is 571-272-8505. The examiner can normally be reached on 9am to 5:30pm Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5 August 2005
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